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10/647,443	08/26/2003	Kil-soo Jung	1793.1003	1643

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EXAMINER	
CHIO, TAT CHI	
ART UNIT	**PAPER NUMBER**
2621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/647,443	JUNG ET AL.	
	Examiner	Art Unit	
	Tat Chi Chio	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/11/2004 and 2/24/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/647440. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application direct to the same invention as the conflicting claims of the copending application. The instant application claims a method of using an apparatus, and the copending application claims the apparatus and playback device that practice the method of the instant application.

Consider claims 1-3, a method of handling a user input in an interactive mode in which played back AV data is displayed with a markup document, the method comprising: when a key input event corresponding to a user action occurs, informing an ENAV engine, which interprets and executes the markup document, of the occurrence of the key input event; and informing, by default, by the ENAV engine, an AV playback engine, which plays back the AV data, of the occurrence of the key input event.

Claims 1-3 of the instant application is conflicting with the claims 1-7 of the copending application, which directs to the apparatus that practices claims 1-3 of the instant application. The claims depending on the claim 1 of the instant application is also affected.

Consider claims 4-6, a method of handling a user input in an interactive mode in which played back AV data is displayed with a markup document, the method comprising: informing by default an AV playback engine, which decodes the AV data, of an occurrence of a key input event corresponding to a user action; and prohibiting, when a second event occurs using second event information recorded in the markup document, the AV playback engine from being informed of the occurrence of the key input event.

Claims 4-6 of the instant application are conflicting with the claims 1-7 of the copending application, which directs to the apparatus that practices claims 4-6 of the instant application. The claims depending on the claim 4 of the instant application is also affected.

Consider claim 7, a method of handling a user input in an interactive mode, comprising: determining whether a key input event occurs as a first event according to first event information recorded in a markup document or via a predetermined key of a remote control pressed by a user; informing, if the key input event occurs, an AV playback engine of occurrence of the key input event via an ENAV engine; determining whether a second event occurs; prohibiting, by the ENAV engine, if the second event occurs, the AV playback engine from being directly informed of occurrence of the key input event; and transmitting, by the ENAV engine, if the key input event matches with second event information recorded in the markup document so that the second event occurs, a control command corresponding to the second event to the AV playback engine.

Claim 7 of the instant application is conflicting with claims 1-7 of the copending application, which directs to the apparatus that practices claim 7 of the instant application.

Consider claim 8, a method of handling a user input in an interactive mode, comprising: determining whether a key input event occurs as a first event according to first event information recorded in a markup document or via a predetermined key of the remote control pressed by a user; informing, if the key input event occurs, an AV playback engine of occurrence of the key input event via an ENAV engine; determining whether user input is forwarded directly to or prohibited from being forwarded to the AV playback engine, referred to as a next event; performing, by the ENAV engine, if the next event occurs, a predetermined operation corresponding to the next event.

Claim 8 of the instant application is conflicting with claims 1-7 of the copending application, which directs to the apparatus that practices claim 8 of the instant application.

Consider claim 9, a method of handling a user input in an interactive mode, comprising: pressing, by a user, a predetermined key of a remote control to cause a key input event; and handling, by an interface handler of an ENAV engine, the key input event by transmitting a playback control command corresponding to the key input event to an AV playback engine.

Claim 9 of the instant application is conflicting with claims 1-7 of the copending application, which directs to the apparatus that practices claim 9 of the instant application.

Consider claim 10, a method of handling a user input in an interactive mode, comprising: pressing, by a user, a predetermined key of a remote control to cause a key input event; informing an interface handler of an ENAV engine of occurrence of the key input event; informing, by the interface handler of the ENAV engine, an AV playback engine of occurrence of the key input event; and performing, by the AV playback engine, an operation corresponding to the key input event.

Claim 10 of the instant application is conflicting with claims 1-7 of the copending application, which directs to the apparatus that practices claim 10 of the instant application.

Consider claim 11, a method of handling a user input in an interactive mode, comprising: clicking, by a user, on a button made in a markup document to cause an

onclick event; and handling, by an interface handler of an ENAV engine, the onclick event by transmitting a playback control command corresponding to the onclick event to an AV playback engine.

Claim 11 of the instant application is conflicting with claims 1-7 of the copending application, which directs to the apparatus that practices claim 11 of the instant application.

Therefore, it is obvious to one of ordinary skill in the art to practice the methods of the instant application by the apparatus of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/647445. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application direct to the same invention as the conflicting claims of the copending application. The instant application claims a method of playing an information storage medium, and the copending application claims the information storage medium played by the method of the instant application.

Consider claims 1-3, a method of handling a user input in an interactive mode in which played back AV data is displayed with a markup document, the method comprising: when a key input event corresponding to a user action occurs, informing an

ENAV engine, which interprets and executes the markup document, of the occurrence of the key input event; and informing, by default, by the ENAV engine, an AV playback engine, which plays back the AV data, of the occurrence of the key input event.

Claims 1-3 of the instant application is conflicting with the claim 1-11 of the copending application, which directs to the information storage medium played by claims 1-3 of the instant application. The claims depending on the claim 1 of the instant application is also affected.

Consider claims 4-6, a method of handling a user input in an interactive mode in which played back AV data is displayed with a markup document, the method comprising: informing by default an AV playback engine, which decodes the AV data, of an occurrence of a key input event corresponding to a user action; and prohibiting, when a second event occurs using second event information recorded in the markup document, the AV playback engine from being informed of the occurrence of the key input event.

Claims 4-6 of the instant application are conflicting with the claims 1-11 of the copending application, which directs to the information storage medium played by claims 4-6 of the instant application. The claims depending on the claim 4 of the instant application is also affected.

Consider claim 7, a method of handling a user input in an interactive mode, comprising: determining whether a key input event occurs as a first event according to first event information recorded in a markup document or via a predetermined key of a remote control pressed by a user; informing, if the key input event occurs, an AV

playback engine of occurrence of the key input event via an ENAV engine; determining whether a second event occurs; prohibiting, by the ENAV engine, if the second event occurs, the AV playback engine from being directly informed of occurrence of the key input event; and transmitting, by the ENAV engine, if the key input event matches with second event information recorded in the markup document so that the second event occurs, a control command corresponding to the second event to the AV playback engine.

Claim 7 of the instant application is conflicting with claims 1-11 of the copending application, which directs to the information storage medium played by claim 7 of the instant application.

Consider claim 8, a method of handling a user input in an interactive mode, comprising: determining whether a key input event occurs as a first event according to first event information recorded in a markup document or via a predetermined key of the remote control pressed by a user; informing, if the key input event occurs, an AV playback engine of occurrence of the key input event via an ENAV engine; determining whether user input is forwarded directly to or prohibited from being forwarded to the AV playback engine, referred to as a next event; performing, by the ENAV engine, if the next event occurs, a predetermined operation corresponding to the next event.

Claim 8 of the instant application is conflicting with claims 1-11 of the copending application, which directs to the information storage medium played by claim 8 of the instant application.

Consider claim 9, a method of handling a user input in an interactive mode, comprising: pressing, by a user, a predetermined key of a remote control to cause a key input event; and handling, by an interface handler of an ENAV engine, the key input event by transmitting a playback control command corresponding to the key input event to an AV playback engine.

Claim 9 of the instant application is conflicting with claims 1-11 of the copending application, which directs to the information storage medium played by claim 9 of the instant application.

Consider claim 10, a method of handling a user input in an interactive mode, comprising: pressing, by a user, a predetermined key of a remote control to cause a key input event; informing an interface handler of an ENAV engine of occurrence of the key input event; informing, by the interface handler of the ENAV engine, an AV playback engine of occurrence of the key input event; and performing, by the AV playback engine, an operation corresponding to the key input event.

Claim 10 of the instant application is conflicting with claims 1-11 of the copending application, which directs to the information storage medium played by claim 10 of the instant application.

Consider claim 11, a method of handling a user input in an interactive mode, comprising: clicking, by a user, on a button made in a markup document to cause an onclick event; and handling, by an interface handler of an ENAV engine, the onclick event by transmitting a playback control command corresponding to the onclick event to an AV playback engine.

Claim 11 of the instant application is conflicting with claims 1-11 of the copending application, which directs to the information storage medium played by claim 11 of the instant application.

Therefore, it is obvious to one of ordinary skill in the art to use the methods of the instant application to play the information storage medium of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lamkin et al. (US 7,178,106 B2).

Consider claim 1, Lamkin et al. teach a method of handling a user input in an interactive mode in which played back AV data is displayed with a markup document, the method comprising: when a key input event corresponding to a user action occurs, informing an ENAV engine, which interprets and executes the markup document, of the occurrence of the key input event (742, 410, 702, 704, 706, 708, 710, 712, 714, and 716

of Fig. 7); and informing, by default, by the ENAV engine, an AV playback engine, which plays back the AV data, of the occurrence of the key input event (422, 426, and 734 of Fig. 7).

Consider claim 2, Lamkin et al. teach the method, wherein the informing of the ENAV engine of the occurrence of the key input event comprises creating the key input event using event information recorded in the markup document (col. 11, lines 56-66), and the informing of the AV playback engine of the occurrence of the key input event comprises transmitting a playback control command corresponding to the key input event to the AV playback engine to handle the key input event (col. 10, lines 4-8).

Consider claim 3, Lamkin et al. teach the method, wherein: the informing of the ENAV engine of the occurrence of the key input event comprises creating the key input event using an onclick event that occurs by clicking on a button made in the markup document, the onclick event being the first event information recorded in the markup document (col. 11, lines 56-66), and the informing of the AV playback engine of the key input event comprises transmitting a playback control command corresponding to the onclick event to the AV playback engine to handle the onclick event (col. 10, lines 4-8).

Consider claim 4, Lamkin et al. teach a method of handling a user input in an interactive mode in which played back AV data is displayed with a markup document, the method comprising: informing by default an AV playback engine, which decodes the AV data, of an occurrence of a key input event corresponding to a user action (422, 426, and 734 of Fig. 7 and col. 19, lines 44-47); and prohibiting, when a second event occurs using second event information recorded in the markup document, the AV

playback engine from being informed of the occurrence of the key input event (col. 19, lines 51-54).

Consider claim 5, Lamkin et al. teach the method, wherein: the prohibiting comprises creating the second event according to the second event information which is recorded using an Application Program Interface (API) (Table A.1.41).

Consider claim 6, Lamkin et al. teach the method, further comprising: controlling the markup picture in correspondence with a third event which occurs according to a third event information recorded in the markup document (col. 19, lines 58-59).

Consider claim 7, Lamkin et al. teach a method of handling a user input in an interactive mode, comprising: determining whether a key input event occurs as a first event according to first event information recorded in a markup document or via a predetermined key of a remote control pressed by a user (col. 19, lines 44-47); informing, if the key input event occurs, an AV playback engine of occurrence of the key input event via an ENAV engine (col. 19, lines 44-47); determining whether a second event occurs (Table A.1.41 and col. 19, lines 51-54); prohibiting, by the ENAV engine, if the second event occurs, the AV playback engine from being directly informed of occurrence of the key input event (Table A.1.41 and col. 19, lines 51-54); and transmitting, by the ENAV engine, if the key input event matches with second event information recorded in the markup document so that the second event occurs, a control command corresponding to the second event to the AV playback engine (Table A.1.41 and col. 19, lines 51-54).

Consider claim 8, Lamkin et al. teach a method of handling a user input in an interactive mode, comprising: determining whether a key input event occurs as a first event according to first event information recorded in a markup document or via a predetermined key of the remote control pressed by a user (col. 19, lines 44-47); informing, if the key input event occurs, an AV playback engine of occurrence of the key input event via an ENAV engine (col. 19, lines 44-47); determining whether user input is forwarded directly to or prohibited from being forwarded to the AV playback engine, referred to as a next event (Table A.1.41 and col. 19, lines 51-54); performing, by the ENAV engine, if the next event occurs, a predetermined operation corresponding to the next event (Table A.1.41 and col. 19, lines 51-54).

Consider claim 9, Lamkin et al. teach a method of handling a user input in an interactive mode, comprising: pressing, by a user, a predetermined key of a remote control to cause a key input event (730 of Fig. 7); and handling, by an interface handler of an ENAV engine, the key input event by transmitting a playback control command corresponding to the key input event to an AV playback engine (702 and 704 of Fig. 7).

Consider claim 10, Lamkin et al. teach a method of handling a user input in an interactive mode, comprising: pressing, by a user, a predetermined key of a remote control to cause a key input event (730 of Fig. 7); informing an interface handler of an ENAV engine of occurrence of the key input event (704 of Fig. 7); informing, by the interface handler of the ENAV engine, an AV playback engine of occurrence of the key input event (702 of Fig. 7); and performing, by the AV playback engine, an operation corresponding to the key input event (col. 11, lines 56-67 and col. 12, lines 1-15).

Consider claim 11, Lamkin et al. teach a method of handling a user input in an interactive mode, comprising: clicking, by a user, on a button made in a markup document to cause an onclick event (col. 8, lines 50-56); and handling, by an interface handler of an ENAV engine, the onclick event by transmitting a playback control command corresponding to the onclick event to an AV playback engine (702 and 704 of Fig. 7).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tat Chi Chio whose telephone number is (571) 272-9563. The examiner can normally be reached on Monday - Thursday 8:30 AM-6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571)-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TCC

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